

Remarks

Claims 1, 13, and 17-80 will be pending upon entry of this amendment.

Claims 23-80 have been added, to more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Support for the amendment to the claims and newly added claims is found throughout the specification as filed.

More particularly, support for new claims 23 and 27 can be found, for example, at page 7, lines 1-10; page 16, lines 5-15; page 70, lines 19-22; and Figures 4a-4b. Support for new claims 24, 28, 33, 38, 45, 52, 69 and 78 can be found, for example, at page 40, lines 1-20; page 196, lines 17-28; and page 239, line 16 to page 241, line 9. Support for new claims 25, 29, 34, 39, 46, 53, 70 and 79 can be found, for example, at pages 337-338. Support for new claims 26, 30, 35, 40, 47, 54, 71 and 80 can be found, for example, at pages 56-69. Support for new claims 31, 32, 36 and 37 can be found, for example, at page 202, lines 3-11. Support for new claims 41-44 and 48-51 can be found, for example, at page 73, lines 1-6; and page 202, lines 3-11. Support for new claims 55-68 can be found, for example, at page 34, lines 5-17; and page 154, lines 15-26. Support for new claims 72-77 can be found, for example, at page 13, lines 26-31; page 73, lines 1-6; and page 74, lines 12-19.

No new matter has been added.

The Restriction Requirement

Claims 2-12 and 14-16 have been canceled without prejudice.

The Examiner has required an election under 35 U.S.C. § 121 of one of thirty-six groups cast by the Examiner. The Examiner contends that the individual groupings are distinct, each from each other.

Preliminarily, Applicants point out that new claims 23-80 fall within the ambit of Group XXIX as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group XXIX, drawn to polypeptides related to BM-HABP (SEQ ID NO:11), represented by new claims 23-80.

With respect to the Examiner's division of the invention into thirty-six groups and the reasons stated therefor, Applicants respectfully traverse.

Applicants point out, that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a “serious burden”. (See M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain of the claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Further, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states. In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, and methods of diagnosing and treating disease states using the proteins of the subject invention would clearly be overlapping. Accordingly, Applicants request that the

Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-XXXVI together in the present application.

Alternatively, Applicants respectfully request that the restriction requirement be modified as follows: Groups I-XVIII should be combined, Groups XIX-XXVII should be combined and Groups XXVIII-XXXVI should be combined. Each member of these proposed combined groups relates to sequences and methods based on the same polypeptide. Thus, for the reasons stated above, it would not be an undue burden to search and examine these claims together.

Moreover, should the Restriction Requirement be made final, Applicants respectfully request that upon indication of allowable subject matter, the Examiner rejoin the claims of Group XXIX with Group XXXIV.


Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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